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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,637	06/02/2000	KALEVI AHOLA	P08581-US1	7880
27045	7590	12/20/2007	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/509,637	Applicant(s) AHOLA, KALEVI	
	Examiner Jason M. Borlinghaus	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21 - 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (US Patent 5,991,748) in view of Official Notice.

Regarding Claims 21 - 27, Taskett discloses a method of paying for calls and services paying for calls and services in a telecommunications network (service provider network), that comprises a charging controller (host computer), the charging controller including a user account database (account database) having user accounts (user data records) that are used by the charging controller to apply prepaid charges and various user services charges (decreases account balance), the method comprising the steps of the user (see abstract; col. 5, lines 18 – 31; col. 7, lines 30 – 65):

- purchasing a voucher or cash instrument (prepaid transaction card) associated with an amount in a voucher record in a voucher database (prepaid account balance stored in host computer). (see col. 3, lines 47 – 50);
- the voucher or cash instrument (prepaid transaction card) having an identifier (identification number) and a secret code (other information necessary for transferring funds from card). (see col. 6, lines 17 – 36);
- utilizing the identifier and the secret code to access the voucher record in the voucher database. (see col. 6, lines 17 – 36; col. 7, lines 30 – 44); and
- transferring a specified amount (selected amount) from the voucher record (data record) in the voucher database (host computer) to a user account in the user account database, wherein the charging controller is adapted for applying user charges to the user account in the user account database (account balance is updated to reflect fund transfer). (see col. 7, lines 30 – 44);
- wherein the voucher (transaction card) record in the voucher database comprises a first field for the identifier of the voucher or cash instrument (identification number of transaction card), a second field for the secret code (other information necessary for transferring funds from card), and a third field for the amount (account balance) of the voucher. (see col. 3, lines 37 – 61; col. 6, lines 17 – 35);
- wherein utilizing a loading service (host computer) for transferring all or part of the amount of the voucher (transaction card) from the voucher record in the

voucher database to a monetary field (account balance) in a user record in the user account database (account database, wherein the user record comprises a plurality of files including a user identifier field (account code) and the monetary field (account balance); (see col. 6, line 58 – col. 7, line 44);

- wherein the amount of the voucher in the voucher record in the voucher database is used only for transferring money to the monetary field in the user record in the user account database. (see col. 6, line 58 – col. 7, line 44);

Taskett does not explicitly teach wherein the identifier and secret code is independent of any association with the user; a fourth field for blocking the voucher; nor a block transferring a specific amount from the voucher record.

However, Examiner takes **Official Notice** that identifiers and other identifying information associated with an anonymous prepaid transaction voucher, such as a prepaid gift card or a gift certificate, relate to the voucher itself and not to the card's anonymous user, which is old and well known in the art of finance and payment methods.

Examiner also takes **Official Notice** that the creating a computer record for blocking a voucher, such as flagging a stolen voucher or a possibly fraudulent transaction, and blocking a transfer over specific amount, such as when a transfer would be in excessive of a card's remaining value or credit limit, is old and well known in the art of finance and payment methods.

It would have been obvious to one of ordinary skill at the invention was made to have modified Taskett to incorporate such methodologies and/or mechanisms, as are

old and well known in the art, as such methodologies and/or mechanisms are standard and conventional in the art.

Regarding Claims 28 - 34, Taskett discloses a method comprising:

- purchasing a voucher or cash instrument (prepaid transaction card) associated with an amount (prepaid account balance) stored in a voucher record in a voucher database (host computer), the voucher or cash instrument (transaction card) having a identifier (identification number). (see col. 3, lines 47 – 60; col. 4, lines 35 – 50);
- a user initiating a prepaid call to a called party. (see col. 1, lines 21 – 39);
- the network routing the call to a prepaid service (host system that manages remote accounts). (see col. 1, lines 21 – 39);
- identifying the caller (via predetermined authorization number). (see col. 1, lines 21 – 39);
- determining the balance (account balance) in a prepaid account (remote account) associated with the user in a user account database (host system). (see col. 1, lines 21 – 39);
- wherein the network connects the caller to the called party. (see col. 1, lines 21 – 39); and
- if the prepaid account (account balance) is empty, notifying (warning/prompting) the caller to load an additional amount to the prepaid account (account balance) associated with the user. (see col. 7, line 45 – col. 8, line 18);

- whereupon the user connects to a loading (regeneration) service of the network. (see col. 7, line 45 – col. 8, line 18);
- the user providing the identifier (credit card number) for accessing the voucher funds. (see col. 1, lines 46 – 53); and
- wherein all or part of the amount in the voucher funds is then sent (withdrawn and deposited) via the loading service (host system) to the prepaid user account. (see col. 1, lines 46 – 53);
- wherein the voucher (transaction card) record in the voucher database comprises a first field for the identifier of the voucher or cash instrument (identification number of transaction card), a second field for the secret code (other information necessary for transferring funds from card), and a third field for the amount (account balance) of the voucher. (see col. 3, lines 37 – 61; col. 6, lines 17 – 35);
- transferring (transferring) all or part of the amount of the voucher or cash instrument (prepaid account balance of prepaid transaction card) in the third field of the record in the voucher database (host computer) to a monetary field (account balance) in the user record (telephone card record) in the user account database (host system). (see col. 3, lines 46 – 54; col. 5, lines 35 – 40; see col. 7, lines 30 – 44);
- wherein the user record comprises a plurality of fields including a user identification field (authorization code) and the monetary field (current balance). (see col. 6, lines 17 – 35); and

- wherein the amount of the voucher in the voucher record in the voucher database is used only for transferring money to the monetary field in the user record in the user account database. (see col. 6, line 58 – col. 7, line 44).

Taskett does not teach a method utilizing an intelligent network, service switching points nor service control points; wherein the identifier and secret code are independent of any association with the user; a fourth field for blocking the voucher or cash instrument; a personal identification number field; nor a block transferring a specific amount from the voucher record.

However, Examiner takes **Official Notice** that utilizing an intelligent network, service switching points and service control points in a telecommunication system is old and well known in the art of telecommunication systems.

Examiner takes **Official Notice** that identifiers and other identifying information associated with an anonymous prepaid transaction voucher, such as a prepaid gift card or a gift certificate, relate to the voucher itself and not to the card's anonymous user, which is old and well known in the art of finance and payment methods.

Examiner also takes **Official Notice** that the creating a computer record for blocking a voucher, such as flagging a stolen voucher or a possibly fraudulent transaction, and blocking a transfer over specific amount, such as when a transfer would be in excessive of a card's remaining value or credit limit, is old and well known in the art of finance and payment methods.

It would have been obvious to one of ordinary skill at the invention was made to have modified Taskett to incorporate such methodologies and/or mechanisms, as are

old and well known in the art, as such methodologies and/or mechanisms are standard and conventional in the art.

Regarding Claim 35, Taskett does not teach that the user account database records and the voucher database records are combined into one database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined records from two databases into one database, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).

Regarding Claims 36 - 41, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Response to Arguments

Applicant's arguments filed 9/21/2007 have been fully considered but they are not persuasive.

Official Notice

In response to applicant's argument(s) that Examiner improperly relied upon knowledge available to one of ordinary skill in the art without specific factual findings, Examiner asserts that "[o]fficial notice without documentary evidence to support an Examiner's conclusion is permissible." *MPEP* §2144.03. Official notice may be taken by the Examiner when the facts asserted to be as being well-known, or to be within common knowledge, in the art are "capable of instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Examiner asserts that such disputed knowledge is old and well known in the art and shall present specific factual findings to establish such claims.

Examiner asserts that the traversal is inadequate. Adequate traversal is a two-step process. First, applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires applicant(s) to specifically point out the supposed errors in the Office Action, applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while applicant(s) have clearly met step (1), applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

However, to further prosecution, Examiner will cite reference(s) along with this Office Action to support the reasoning behind using Official Notice and why it would have been obvious to one of ordinary skill in the art. For example:

Walker-Leigh (Walker-Leigh, Vanya. *US Vanguard Visits France to Look at the Smart Card. The American Banker*. August 11, 1982. pp. 3 - 7) discloses an anonymous

prepaid transaction voucher (anonymous prepaid card) wherein identifiers (specific amount of videotext units) and secret code (PINs) relate to the voucher and not the card's anonymous user. (see p. 6). Other interpretation of disclosure would negate the concept of an anonymous prepaid card.

D'Urso (US Patent 5,353,335) discloses a computer record (fraud indicator or flag) for blocking a voucher (prepaid phone card), such as flagging a stolen voucher or a possibly fraudulent transaction. (see col. 7, line 46 – col. 8, line 8).

Rosen (US Patent 5,453,601) discloses a computer record for blocking a transfer over a specific amount (funds on balance at the bank), such as when a transfer would be excessive of a card's (e.g. card or money module) remaining value or credit limit. (see col. 2, lines 15 – 23; col. 43, line 57 – col. 44, line 3).

Wakamoto (US Patent 5,526,415) discloses utilizing an intelligent network, service switching points and service control points in a telecommunication system. (see abstract).

Thus, it is for these reasons that Examiner believes taking Official Notice is proper and that such methodologies were well known at the time of applicant's invention. Examiner also submits that the citation of the references above has been added as evidence to substantiate the prior Official Notice statement, does not result in a new issue, and therefore this action will be made Final.

Rejections Under 103 (a)

Applicant asserts that the cited prior art does not disclose the claim limitations. If Examiner understands Applicant's arguments correctly, Applicant takes issue with Examiner's mapping of the claim language to the Taskett reference. Furthermore, the Applicant appears to argue that in contrast to what is being claimed "[t]he Taskett prepaid transaction card is personally associated with the user." Examiner refutes such an argument.

Taskett discloses a prepaid transaction card (see col. 3, lines 46 – 54). Alternatively, Taskett discloses a credit or charge card (see col. 3, line 62 - col. 4, line 3). Taskett discloses transferring value from either of these transaction cards to a prepaid telephone card. (see col. 4, lines 4 - 15).

A prepaid transaction card by nature is anonymous. When a user purchases a prepaid transaction card containing a value of \$100, the user has a card encoded with a \$100 in value. There are no additional associations between the information contained on the card and the user. The user's name is not encoded upon the card. Other accounts (e.g. checking or credit accounts) registered in the user's name are not encoded upon the card. That is the whole purpose of a transaction card being prepaid, the transaction card is a self-contained instrument containing a prepaid value. Having other information about the user encoded upon the prepaid transaction card defeats the disposable and anonymous nature of prepaid transaction cards.

Examiner thought that such was apparent upon the face of Taskett but took Official Notice (now evidenced by Walker-Leigh) of the anonymous nature of prepaid transaction cards to buttress this concept.

To simplify the Examiner's application of the cited prior art, Examiner interpreted Claim 21 as transferring value from one account (an account associated with a prepaid transaction card) to a second account (an account associated with a prepaid telephone card) to be applied to charges (telephone charges) incurred by the second account (an account associated with a prepaid telephone card).

Examiner believes that the crux of Applicant's argument is that Applicant intends a different meaning or intent beyond which is actually claimed. However, the Examiner is required to utilize the broadest definition for the term as to provide the "broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims." *See In re Prater and Wei*, 162 USPQ 541, 550 (CCPA 1969).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

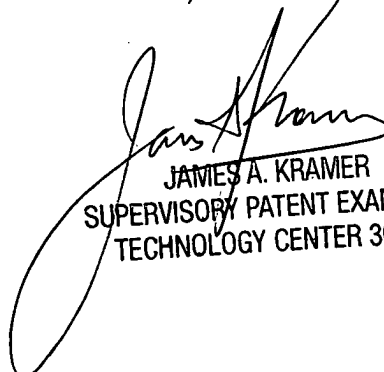
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason Borlinghaus

December 19, 2007

 12.20.07
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